



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

ATTY.'S DOCKET: CAO=1

In re Application of:)	Confirmation No.: 9498
)	
Chunyu CAO et al)	Art Unit: 1636
)	
I.A. Filing Date: 07/11/2003)	Examiner: K. A. Makar
371(c) Date: December 30, 2004)	September 21, 2006
)	
U.S. Appln. No.: 10/520,008)	
)	
For: METHOD OF TRANSFERRING)	
MUTATION INTO TARGET...)	

REPLY TO RESTRICTION REQUIREMENT

Customer Service Window, Mail Stop Amendment
Honorable Commissioner for Patents
U.S. Patent and Trademark Office
Randolph Building
401 Dulany Street
Alexandria, Virginia 22314

Sir:

Applicants are in receipt of the Office Action
mailed August 21, 2006, and applicants Reply below.

First, however, applicants respectfully note the
acknowledgement by the PTO of the receipt of applicants'
papers filed under Section 119.

Restriction has been required between what the PTO
deems as being two (2) patentably distinct inventions,
purportedly on the basis of lack of unity of invention under
PCT Rules 13.1 and 13.2. As applicants must make an election

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Chunyu CAO et al

Application No.: 10/520,008

I. A. Filing Date: July 11, 2003

Filed: December 30, 2004

For: ...METHOD OF TRANSFERRING MUTATION INTO TARGET...

Customer Service Window, Mail Stop Amendment

Honorable Commissioner for Patents
U.S. Patent and Trademark Office
Randolph Building, 401 Dulany Street
Alexandria, Virginia 22314



Art Unit: 1636

Examiner: K. A. Makar

Washington, D.C.

Atty.'s Docket: CAO=1

Confirmation No.: 9498

Date: September 21, 2006

Sir:

Transmitted herewith is a REPLY TO RESTRICTION REQUIREMENT in the above-identified application.

☐ Small Entity Status: Applicant(s) claim small entity status. See 37 C.F.R. §1.27.

☒ No additional fee is required.

☐ The fee has been calculated as shown below:

	(Col. 1)		(Col. 2)	(Col. 3)
	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA EQUALS
TOTAL	*	MINUS	** 20	0
INDEP.	*	MINUS	*** 3	0
FIRST PRESENTATION OF MULTIPLE DEP. CLAIM				

ADDITIONAL FEE TOTAL

SMALL ENTITY	
RATE	ADDITIONAL FEE
x 25	\$
x 100	\$
+ 180	\$
ADDITIONAL FEE TOTAL	

OTHER THAN SMALL ENTITY	
RATE	ADDITIONAL FEE
x 50	\$
x 200	\$
+ 360	\$
TOTAL	

OR

- * If the entry in Col. 1 is less than the entry in Col. 2, write "0" in Col. 3.
- ** If the "Highest Number Previously Paid for" IN THIS SPACE is less than 20, write "20" in this space.
- *** If the "Highest Number Previously Paid for" IN THIS SPACE is less than 3, write "3" in this space.

The "Highest Number Previously Paid For" (total or independent) is the highest number found from the equivalent box in Col. 1 of a prior amendment of the number of claims originally filed.

☒ Conditional Petition for Extension of Time

If any extension of time for a response is required, applicant requests that this be considered a petition therefor.

☐ It is hereby petitioned for an extension of time in accordance with 37 CFR 1.136(a). The appropriate fee required by 37 CFR 1.17 is calculated as shown below:

Small Entity

Response Filed Within

- ☐ First - \$ 60.00
- ☐ Second - \$ 225.00
- ☐ Third - \$ 510.00
- ☐ Fourth - \$ 795.00

Month After Time Period Set

Other Than Small Entity

Response Filed Within

- ☐ First - \$ 120.00
- ☐ Second - \$ 450.00
- ☐ Third - \$ 1020.00
- ☐ Fourth - \$ 1590.00

Month After Time Period Set

☐ Less fees (\$) already paid for month(s) extension of time on .

☐ Please charge my Deposit Account No. 02-4035 in the amount of \$.

☐ Credit Card Payment Form, PTO-2038, is attached, authorizing payment in the amount of \$.

☐ A check in the amount of \$ is attached (check no.).

☒ The Commissioner is hereby authorized and requested to charge any additional fees which may be required in connection with this application or credit any overpayment to Deposit Account No. 02-4035. This authorization and request is not limited to payment of all fees associated with this communication, including any Extension of Time fee, not covered by check or specific authorization, but is also intended to include all fees for the presentation of extra claims under 37 CFR §1.16 and all patent processing fees under 37 CFR §1.17 throughout the prosecution of the case. This blanket authorization does not include patent issue fees under 37 CFR §1.18.

Facsimile: (202) 737-3528
Telephone: (202) 628-5197

BROWDY AND NEIMARK, P.L.L.C.

Attorneys for Applicant(s)

By:

Sheridan Neimark
Registration No. 20,520

even though the requirement is traversed, applicants hereby respectfully and provisionally elect Group I, presently designated as claims 1-10, with traverse and without prejudice.

Applicants respectfully submit that Hackett et al U.S. patent 6,489,458 does not anticipate applicants' invention for reasons which will be pointed out if Hackett is applied as prior art, and therefore Hackett does not destroy unity of invention. In short, there is more to applicants' invention than what is outlined in numbered paragraphs 2 and 3 on page 2 of the Official Action.

Moreover, the non-elected kit claims precisely parallel the elected method claims. Also, the kit claims depend from and incorporate by reference the subject matter of method claim 1. Under these conditions, applicants submit and believe that a complete search of the elected method would also require a search of the kit. Indeed, insofar as is known, the kit and the method are commonly classified, and the PTO has not alleged divergent classification sufficient to create a "serious burden" in searching and examining both groups. Accordingly, applicants also respectfully rely on the second paragraph of MPEP 803 which **requires** a complete search and examination of an entire application, even when the

Appln. No. 10/520,008
Amd. dated September 21, 2006
Reply to Office Action of August 21, 2006

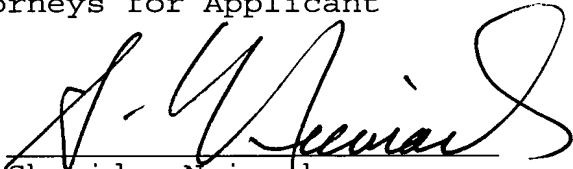
requirement is correct, if it would not constitute a serious burden to do so.

Applicants therefore respectfully request withdrawal of the requirement and examination of all the claims on the merits.

Applicants now respectfully await the results of a first examination on the merits.

Respectfully submitted,

BROWDY AND NEIMARK, P.L.L.C.
Attorneys for Applicant

By 
Sheridan Neimark
Registration No. 20,520

SN:kg
Telephone No.: (202) 628-5197
Facsimile No.: (202) 737-3528
G:\BN\A\Aoyb\Caol\pto\2006-09-21 PCTREPLY.doc